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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/095,478	06/10/98	GREGORY D.	235/054

022249  
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HM12/1004

EXAMINER  
SUN HOFFMAN, L

ART UNIT	PAPER NUMBER
1642	6

DATE MAILED: 10/04/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.  
09/095,478

Applicant(s)  
Plowman et al.

Examiner  
Lin Sun-Hoffman

Group Art Unit  
1642



☐ Responsive to communication(s) filed on \_\_\_\_\_

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-22 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☐ Claim(s) \_\_\_\_\_ is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☒ Claims 1-22 are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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## DETAILED ACTION

### *Election/Restriction*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-9, drawn to a nucleotide encoding a PTP05 or PTP10, classified in class 536, subclass 23.1.
  - II. Claims 10-12, drawn to a polypeptide of PTP05 or PTP10, classified in class 530, subclass 350.
  - III. Claims 13-14, drawn to an antibody, classified in class 530, subclass 387.1.
  - IV. Claims 15, drawn to a method for identifying a substance, classified in class 435, subclass 7.1.
  - V. Claims 17-22, drawn to a method of treatment and a kit, classified in class 514, subclass 2; class 424, subclass 93.1.

Group I and II are subject to further restriction to either elect a nucleotide either express PTP05 or PTP10, or a polypeptide of PTP05 or PTP10.

2. The inventions are distinct, each from the other because of the following reasons:

Inventions Group I-V are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together, or they have different modes of operation, or they have different functions, or they have different effects.(MPEP §806.04, MPEP § 808.01). In the instant case the different inventions are directed to structurally different proteins. Inventions I, II,

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III and IV and V are unrelated because the polynucleotides of invention I can be used in hybridizations assays whereas the inventions of II-V cannot, the proteins of invention II can be used in affinity purification schemes and to make antibodies, whereas the polynucleotides of invention I cannot, the antibodies of invention III can be used in immunoassays whereas the inventions of I and II cannot. The methods of inventions IV-V are distinct from each other or from other inventions because they either treat different diseases with a different factor or are completely unrelated to treatment (i.e., identification of a new factor).

3. Because these inventions are distinct for the reasons given above and have acquired separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. Due to the complexity of this restriction, a telephone call to request an oral election to the above restriction requirement was not made.
5. Applicants are advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).
6. Applicants are reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(h).

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7. **Please Note:** In an effort to enhance communication with our customers and reduce processing time, Group 1640 is running a Fax Response Pilot for Written Restriction Requirements. A dedicated Fax machine is in place to receive your responses. The Fax number is 703-305-3704. A Fax cover sheet is attached to this Office Action for your convenience. We encourage your participation in this Pilot program. If you have any questions or suggestions please contact Paula Hutzell, Ph.D., Supervisory Patent Examiner at Paula.Hutzell@uspto.gov or 703-308-4310. Thank you in advance for allowing us to enhance our customer service. Please limit the use of this dedicated Fax number to responses to Written Restrictions.

***Conclusion***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lin Sun-Hoffman, Ph.D., whose telephone number is (703)-308-7552. The examiner can normally be reached on Monday to Friday from 7:30 am to 4:00 pm Eastern Standard Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paula Hutzell, Ph.D., who can be reached on (703) -308-4301.

Lin Sun-Hoffman, Ph.D.



September 30, 1999

  
**PAULA K. HUTZELL**  
**SUPERVISORY PATENT EXAMINER**